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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,010	06/29/2000	Masato Okabe	CU-2263 TFP	7333

7590

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Thomas F Peterson  
c/o Ladas & Parry  
224 South Michigan Avenue  
Chicago, IL 60604

EXAMINER

MCPHERSON, JOHN A

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 11/01/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/607,010

Applicant(s)

OKABE ET AL.

Examiner

John A. McPherson

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is responsive to the Amendment dated 9/26/02.
2. The Amendment dated 9/26/02 successfully overcomes the rejections set forth in paragraphs 1-3 of the Office Action dated 6/28/02. Accordingly, these rejections are withdrawn.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 10-11, 14 and 16-28 are rejected under 35 U.S.C. 102<sup>e</sup>(~~b~~) as being anticipated by U.S. Patent No. 6,399,257 to Shirota et al. (Shirota) for the reasons of

Art Unit: 1756

record as set forth in paragraph 4 of the Office Action dated 6/28/02, and as further discussed below.

4. Claims 18-27 are rejected under 35 U.S.C. 102<sup>b</sup>(e) as being anticipated by WO99/08158 (WO '158) for the reasons of record as set forth in paragraph 5 of the Office Action dated 6/28/02, and as further discussed below.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/08158 (WO '158) in view of EP 0 665 449 (EP '449). WO '158 discloses a pattern forming body for optically forming a pattern, characterized by having a photocatalyst-containing layer on a substrate, the layer containing a material whose wettability is changed when the pattern is exposed to light. Applications include a color filter and methods of preparing the same. See the abstract. Furthermore, WO '158 discloses a process of forming a color filter comprising the steps of forming a photocatalyst layer on a substrate; exposing the substrate to light to bring light exposed areas to a high critical surface tension state, thereby forming areas of specific wettability; and feeding colored coating compositions to the photocatalyst layer by a

Art Unit: 1756

coating method such as ink jetting. See Figures 13-21 of WO '158, which are described in the English language at column 7, line 53 to column 10, line 25 and column 33, line 8 to column 38, line 12 of U.S. Patent No. 6,294,313 (the 35 USC 371 U.S. patent related to WO '158). However, WO '158 does not disclose a color filter not having a shading part provided on a border part (i.e. not having a black matrix).

EP '449 discloses a color filter produced by a process comprising the steps of forming a layer of a resin composition on a substrate having a wettability by ink which is lowered or improved by light exposure, subjecting the resin layer to patterned exposure, ejecting inks using an ink-jet system to separately color portions of the resin layer (see page 4, lines 43 to page 5, line 9), wherein the substrate may either be provided with a black matrix beneath the wettability-changing layer (see page 8, line 57 to page 9, line 22, and Figures 8A-F and 11) or alternatively not provided with a black matrix beneath the wettability-changing layer (see page 9, lines 23-37, and Figures 10A-E and 12). It would have been obvious to one skilled in the requisite art to provide a substrate without a black matrix, as taught by EP '449, in the color filter and process of WO '158 because it is taught that substrates with and without black matrices are art-recognized alternatives for use when forming color filters changing the wettability of an overlying layer and supplying ink thereto, and such an alternative provides a color filter for use in a liquid crystal display panel in which a black matrix is provided on a base opposite to the color filter.

***Response to Arguments***

6. Applicant's arguments filed 9/26/02 have been fully considered but they are not persuasive.

With respect to the rejection over Shirota, Applicant argues that this patent is not a proper reference under 35 USC 102(e) because the latest foreign priority date of the present application is before the filing date of the Shirota patent. However, Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

With respect to the rejection over WO '158, Applicant argues that the present invention, as amended, relates to a color filter which does not comprise a shading part (black matrix), while WO '158 discloses only a color filter with a shading part, and neither discloses nor suggest a color filter without a shading part. However, only the embodiments of independent claim 1 and the claims which depend therefrom have been amended so as to exclude the presence of a shading part. The embodiments of independent claims 18 and 22, along with their dependent claims, do not include this new limitation.

Furthermore, in view of the teachings of EP '449, it is the position of the Examiner that it would have been obvious to one skilled in the requisite art to exclude the shading parts from the color filter and process of WO '158, as set forth above in the newly presented 35 USC 103 rejection of paragraph 5.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (703) 308-2302. The examiner can normally be reached on Monday through Friday, 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (703) 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Art Unit: 1756

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John A. McPherson  
Primary Examiner  
Art Unit 1756

JAM  
October 31, 2002